

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERVASIO MERCURI

Appeal 2006-2319
Application 09/869,094
Technology Center 1700

Decided: September 28, 2006

Before GARRIS, WARREN, and LINCK, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Examiner's decision rejecting claims 45-66.

We REVERSE.

The subject matter on appeal relates to a tubular structure casing for use with food products. With reference to the Appellant's drawing, the tubular structure comprises circumferential threads 16 (*see* Fig. 3) comprising an elastic thread 11 in combination with a yarn 12 wrapped therearound (*see* Figs. 1-2), whereby the circumferential threads become taut after a predetermined amount of stretch due to the yarn being straightened to an extent where the yarn resists tensile force (*see* Fig. 2), whereupon the circumferential threads become inextensible before the elastic limit of the elastic thread is reached. This appealed subject matter is adequately represented by claim 45, which is the sole independent claim on appeal and which reads as follows:

45. A tubular structure casing for use with food products, comprising:

circumferential threads extending around a periphery of a tubular casing and spaced at intervals along said tubular casing, said circumferential threads comprising an elastic thread in combination with a yarn wrapped around and along a length of said elastic thread, wherein a number of turns of said yarn are provided around said elastic thread for a given length of said circumferential threads [and] are determined as a function of an elastic limit of said elastic thread so that said circumferential threads become taut after a predetermined amount of stretch due to said yarn being straightened to an extent where said yarn resists tensile force whereupon said circumferential threads become inextensible before the elastic limit of said elastic thread is reached.

The references set forth below are relied upon by the Examiner as evidence of anticipation and obviousness:

Krauss	US 3,248,905	May 3, 1966
Levin	US 3,866,444	Feb. 18, 1975
Mercuri	US 5,712,007	Jan. 27, 1998
Mintz	US 5,855,231	Jan. 5, 1999

Claims 45-47, 54-57, and 63-66 are rejected under 35 U.S.C. § 102(b) as being anticipated by either Levin or Krauss.

The remaining claims on appeal are rejected under 35 U.S.C. § 103(a) as being unpatentable over Levin or Krauss in varying combinations with the other references relied upon by the Examiner.

We refer to the Brief and Reply Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the Appellant and by the Examiner concerning the rejections before us in this appeal.

Neither Levin nor Krauss contains an express teaching of the claim 45 functional limitation “so that said circumferential threads become taut after a predetermined amount of stretch due to said yarn being straightened to an extent where said yarn resists tensile force whereupon said circumferential threads become inextensible before the elastic limit of said elastic thread is reached.” It is the Examiner’s basic position that the casings of Levin and Krauss inherently possess the capability of performing the claim 45 function (see the Answer in its entirety).

“In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the

determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (CCPA 1995). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

On the record of this appeal, the Examiner has failed to carry his burden of providing a basis-in-fact and/or technical reasoning to reasonably support the determination that the allegedly inherent functional characteristic under consideration necessarily flows from the teachings of Levin or Krauss. *Levy*, 17 USPQ2d at 1464. Contrary to the Examiner’s apparent belief, the respective casings of Levin and Krauss do not inherently possess the capability of performing the claim 45 function merely because these casings include “circumferential threads” which comprise an elastic rubber thread having yarn wrapped therearound. This is because the “circumferential threads” of Levin and Krauss may become inextensible as a result of reaching the elastic limit of the elastic rubber thread (rather than as a result of the yarn resisting tensile force before the elastic limit of the elastic rubber thread is reached pursuant to the claim under review).

Indeed, the teachings of Levin and Krauss militate against the Examiner’s inherency position. For example, Levin teaches that, when his

“circumferential threads” 12 are extended under tension, the “covering strands [see elements 12c and 12d in Fig. 5 which the Examiner equates to the here claimed yarn] become somewhat spaced” (col. 3, ll. 26-30 (emphasis added)). The fact that the strands (or yarns) become only “somewhat” spaced, when the “circumferential threads” 12 are tensioned, reflects that the elastic limit of these “circumferential threads” is not provided by the strands (or yarns) as required by the independent claim on appeal. Similarly, Krauss teaches that his cords (e.g., see elements 28 and 30 in Fig. 4 which the Examiner equates to the here claimed yarn) are wrapped around the elastic core in order to “prevent exposure of the elastic core which tends to contract on exposure to heat” (col. 2, ll. 20-21). Moreover, claim 1 of Krauss expressly recites that the elastic core has a covering (i.e., the afore-noted cords) “which affords continuous and uninterrupted protection for said core under stretch conditions.” The fact that Krauss’s covering provides the elastic core with continuous and uninterrupted protection under stretch conditions militates against the Examiner’s position that this covering of cords becomes straightened to an extent where the cords resist tensile force as required by claim 45.

In light of the foregoing, it is our determination that the Examiner has failed to establish a prima facie case of anticipation based on inherency. Therefore, we cannot sustain the Examiner’s § 102 rejections based on either Levin or Krauss. We also cannot sustain any of the § 103 rejections advanced on this appeal since the other references applied in these rejections

Appeal 2006-2319
Application 09/869,094

have not been relied upon by the Examiner to supply the above-discussed deficiencies of Levin and Krauss.

The decision of the Examiner is reversed.

REVERSED

clj

Crowell & Moring LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300